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10/711,705	09/30/2004	Henry W. Grant, Jr.	014033.000047	5704

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EXAMINER
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NORMAN, SAMICA L

ART UNIT	PAPER NUMBER
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3696

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,705	<b>Applicant(s)</b> GRANT, JR. ET AL.	
	<b>Examiner</b> SAMICA L. NORMAN	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 4-14, 16, 17-20, 23-27 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 27 and 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14, 16, 17, 19, 20 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 2, 3, 15, 18, 21, 23, 28 and 29 are cancelled.

The second paragraph of 35 U.S.C. 112 Rejection is withdrawn due to applicant's current amendment.

### ***Election/Restrictions***

1. Claims 1-10, 27 and 30-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Inventions I and II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 22, 2008.

### ***Claim Objections***

2. Claims 11-14, 16, 17, 19, 20 and 23-26 are not supported by the specification. Claim 11 recites "determining the risk comprises" with subsequent limitations. The specification does not state that the "determining the risk" comprises all of the subsequent limitations. Similarly claim 17 recites "the predetermined criteria comprising" with subsequent limitations. The specification does not state that the "predetermined criteria" comprises all of the subsequent limitations.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Referring to claims 1 and 27. In many instances it is clear within which of the enumerated categories a claimed invention falls. The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- but rather on the essential characteristics of the subject matter, in particular, its practical utility. In the instant invention, the claimed subject matter does not cover either a 101 judicial exception or a practical application of a 101 judicial exception. The claimed subject matter is merely directed towards an abstract idea. While a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge or scientific truth may be. *Diehr*, 450 U.S. at 188, 209 USPQ at 8-9. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy*, 55 U.S. (14 How.) at 175.

4. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform

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underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. *See Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11-14, 16, 17, 19, 20 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence et al., U.S. PG-Pub No. 2002/0138407 (reference A on the attached PTO-892).

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7. As per claim 11, Lawrence et al. teaches a method to evaluate anti-money laundering risk, comprising: identifying a person or other legal entity to be evaluated (see paragraph 0042, lines 1-4); selecting a country associated with the person or other legal entity; selecting at least one financial product or investment associated with the person or other legal entity (see paragraph 0045, lines 3-10); selecting a customer type associated with the person or other legal entity (see paragraph 0048, lines 1-4); and determining a risk rating based on responses to predetermined criteria or question related to the selected country, the at least one selected financial product or investment and the selected customer type (see paragraph 0048, lines 16-20), wherein determining the risk rating comprises: allowing input of the person or other legal entity's sophistication (see paragraph 0024, lines 1-2); evaluating the person or other legal entity's sophistication with respect to the at least one selected financial product or investment (see paragraph 0027, lines 4-7); determining the at least one selected financial product or investment's propensity for use for money laundering (see paragraph 0045, lines 3-10); determining the at least one selected financial product or investment's attractiveness for use by terrorist; allowing input of a level of complexity of the at least one selected financial product or investment (see paragraph 0024, lines 1-2); evaluating the level of complexity of the at least one selected financial product or investment; determining if the at least one selected financial product or investment is currently monitored for use with respect to illegal activity; determining a level of the person or other legal entity's knowledge of the at least one financial product or investment; and determining a level of ease of obtaining and using the at least one financial product or investment; and presenting the risk rating to a user (see paragraph 0054, lines 1-4).

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8. As per claim 12, Lawrence et al. teaches the method of claim 11 as described above.

Lawrence further teaches wherein determining the risk comprises setting a value corresponding to each of the responses to the predetermined criteria or question (see paragraph 0048, lines 4-8).

9. As per claim 13, Lawrence et al. teaches the method of claim 12 as described above.

Lawrence further teaches wherein determining the risk comprises calculating one of an average or a weighted average of the values based on the selected country, the at least one selected financial product or investment and the selected customer type (see paragraph 0037, lines 3-6).

10. As per claim 14, Lawrence et al. teaches the method of claim 11 as described above.

Lawrence further teaches wherein determining the risk comprises at least one of: evaluating if the selected country is a cooperative jurisdiction; determining if the selected country was a party to the 1988 United Nations Convention on drugs; evaluating a quality of banking regulation and oversight in the selected country; determining if the selected country is associated with terrorist related activity or on the Office of Foreign Asset Control (OFAC) list; evaluating a quality of local laws of the selected country; entering an International Narcotics Strategy Report Rating for the selected country; evaluating a level of government support in the selected country for enforcement of laws and regulations and prosecution of offenses; determining if the selected country is a member of Financial Action Task Force on Money Laundering (FATF); and determining strength of a banking industry in the selected country (see paragraph 0054, lines 6-11).

11. As per claim 16, Lawrence et al. teaches the method of claim 11 as described above.

Lawrence further teaches wherein determining the risk comprises at least one of: determining if the person or other legal entity is currently being monitored with respect to financial activity;

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determining a level of risk of the person or other legal entity being associated with terrorist activity; evaluating a level of knowledge about the person or other legal entity; and determining if the person or other legal entity is known to be a high risk (see paragraph 0045, lines 3-10 and paragraph 0048, lines 16-20).

12. As per claim 17, Lawrence et al. teaches a system to evaluate anti-money laundering risk, comprising: a server (see paragraph 0038, lines 1-5); and a risk rating tool operable on the server (see paragraph 0039, lines 1-6), wherein the risk rating tool is adapted to determine a risk rating based on responses to predetermined criteria related to a selected country, at least one selected financial product and a selected customer type (see paragraph 0048, lines 16-20), and wherein the risk rating tool is programmed to determine a risk rating based on responses to the predetermined criteria related to at least one selected financial product or investment (see paragraph 0026, lines 9-12 and paragraph 0032, lines 4-6), the predetermined criteria comprising: a customer sophistication with respect to the selected financial product or investment (see paragraph 0024, lines 1-2); a propensity of the selected financial product or investment for use for money laundering (see paragraph 0045, lines 3-10); an attractiveness of the selected financial product or investment for use by terrorist; a level of complexity of the financial product or investment (see paragraph 0024, lines 1-2); a current monitoring of the financial product or investment for use with respect to illegal activity; a level of a customer's or public's knowledge of the financial product or investment; and a level of ease of obtaining and using the financial product or investment.



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13. As per claim 19, Lawrence et al. teaches the system of claim 18 as described above.

Lawrence further teaches a value being set corresponding to each of the responses to the predetermined criteria (see paragraph 0048, lines 4-8).

14. As per claim 20, Lawrence et al. teaches the system of claim 19 as described above.

Lawrence further teaches wherein the risk rating tool is programmed to calculate one of an average or a weighted average of the values based on the selected country, the at least one selected financial product and the selected customer type (see paragraph 0037, lines 3-6).

15. As per claim 23, Lawrence et al. teaches the system of claim 17 as described above.

Lawrence further teaches wherein the risk rating tool is programmed to determine a risk rating based on responses to predetermined criteria related to a selected customer type, the predetermined criteria comprising: a customer currently being monitored with respect to financial activity; a level of risk of the customer being involved in terrorist activity; a level of a financial institutions knowledge of its customer; and the customer being known to be a high risk (see paragraph 0045, lines 3-10 and paragraph 0048, lines 16-20).

16. As per claim 24, Lawrence et al. teaches the system of claim 17 as described above.

Lawrence further teaches wherein the risk rating tool is programmed to calculate a risk rating based on a set of values, each value being assigned to one of a plurality of different possible or selectable responses or answers for each of a multiplicity of criteria or questions associated with a group including at least one of a selected country, a selected financial product or investment and a selected customer type (see paragraph 0026, lines 9-12 and paragraph 0032, lines 4-6).

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17. As per claim 25, Lawrence et al. teaches the system of claim 24 as described above.

Lawrence further teaches a database including reports used to determine each of the set of values (see paragraph 0051, lines 1-2).

18. As per claim 26, Lawrence et al. teaches the system of claim 17 as described above.

Lawrence further teaches wherein the risk rating tool is programmed to present a graphical user interface for a user to select at least one of: if the selected country is a cooperative jurisdiction; if the selected country is on an Office of Foreign Asset Control (OFAC) list; an International Narcotics Strategy Report Rating associated with the selected country; if the selected country is a member of the Financial Task Force on Money Laundering (FATF); if the selected country was a party to a 1988 United Nations Convention; a quality of local laws and regulations associated with the selected country; a level of government support related to enforcement of laws and regulations and prosecution of offenses; a strength of a banking industry associated with the selected country; and a quality of banking regulation and oversight associated with the selected country (see paragraph 0054, lines 6-11).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 11-14, 16, 17, 19, 20 and 23-26 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Applicant(s) are reminded that as a matter of linguistic precision, optional or conditional elements (e.g. "if," "may," etc.) do not narrow the claims because they can always be omitted. See also MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMICA L. NORMAN whose telephone number is (571)270-1371. The examiner can normally be reached on Mon-Thur 6:30a-5p, w/ Fri off.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

sln